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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,619	11/17/2000	Harold P. Mintz	12763	5426
25570	7590	03/06/2006		
ROBERTS, MLOTKOWSKI & HOBBS P. O. BOX 10064 MCLEAN, VA 22102-8064			EXAMINER HAMILTON, LALITA M	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/714,619

Applicant(s)

MINTZ, HAROLD P.

Examiner

Lalita M. Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br/>         Paper No(s)/Mail Date _____.</p> | <p>4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br/>         Paper No(s)/Mail Date. <u>02152006</u>.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
|---|--|

## **DETAILED ACTION**

### **Summary**

On November 11, 2005, the Applicant filed a Request for Reconsideration. On February 13, 2006, an Advisory Action was sent to the Applicant reopening prosecution. After consulting with another Primary Examiner on allowability and conducting another search, the Examiner found it necessary to reopen prosecution. A new non-final rejection follows.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-19 and 21-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Spivey (6,571,219).

Spivey discloses a method and corresponding system for stock ownership comprising operating a venture capital investment business, establishing a business entity, said business entity establishing an investment fund for venture capital, establishing a fund managing entity of said investment fund, said fund managing entity attending to administrative matters relating to said investment fund and making

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investment decisions for the fund, said investment fund having investors that provide capital contributions to said fund, said fund managing entity also providing capital contributions to said fund, said fund utilizing said contributions to invest in portfolio entities, said investors receiving a general participation interest in said fund, and said fund managing entity receiving a carried interest in said fund, and providing said investors that have provided at least a threshold capital contribution to said fund with stock rights in said business entity to enable such investors to become shareholders in said business entity (col.10, line 10 to col.11, line 35; col.25, line 1 to col.71, line 14—non-limiting example; and fig.1—all); a business entity securing a portion of IPO shares that become available in portfolio entities, and business entity enabling shareholders thereof to purchase IPO shares said portion of IPO shares secured by said business entity that become available in said portfolio entities (col.10, line 10 to col.11, line 35); shareholders of said business entity will be entitled to a percentage of said portion of IPO shares that is based on a pro-rata percentage of their stock ownership in said business entity, less any shares allocated otherwise (col.10, line 10 to col.11, line 35); an amount of IPO shares that said at least one other fund managing entity is entitled to obtain is based upon the performance of said fund and/or tenure of said at least one other fund managing entity (col.10, line 10 to col.11, line 35; col.25, line 1 to col.71, line 14; and fig.1—all); fund managing entity employs at least one other fund managing entity to direct investment decisions, said at least one other fund managing entity also being provided with stock rights in said business entity (col.10, line 10 to col.11, line 35); portfolio entities also receive stock rights in said business entity (col.10, line 10 to

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col.11, line 35); shareholders in said business entity include direct shareholders in business entity, said investors in said fund that have exercised stock options that they obtained in said business entity, said at least one other fund managing entity that has exercised stock options that it obtained in said business entity, and said portfolio entities that have exercised stock options that they obtained in said business entity (col.10, line 10 to col.11, line 35); business entity invests directly in additional portfolio entities, other than said portfolio entities invested in through said investment fund (col.10, line 10 to col.11, line 35; col.25, line 1 to col.71, line 14; and fig.1—all); an investment manager/advisor that provides investment advice to the fund (col.10, line 10 to col.11 and fig.1—all); business entity establishes a family of investment funds, each of said funds investing in associated portfolio entities, providing investors that have provided at least a threshold capital contribution to at least one of said funds stock rights in said business entity to enable such investors to become shareholders in said business entity, and said business entity enabling shareholders thereof to purchase shares that become available in any of said portfolio entities of said family of funds (col.10, line 10 to col.11, line 35; col.25, line 1 to col.71, line 14; and fig.1—all); portfolio entities are also provided with stock rights in the business entity (col.10, line 10 to col.11, line 35; col.25, line 1 to col.71, line 14; and fig.1—all); investment fund having investors that provide capital contributions to said fund, said fund managing entity also providing capital contributions to said fund, said fund utilizing said capital contributions to invest in portfolio entities, and providing investors that have provided a threshold capital contribution amount to said fund with stock rights to purchase shares in said business

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entity (col.10, line 10 to col.11, line 35; col.25, line 1 to col.71, line 14; and fig.1—all); investors are provided with stock rights to purchase shares in the business entity partial consideration for said shareholders agreeing for said business entity to secure rights (col.10, line 10 to col.11, line 35; col.25, line 1 to col.71, line 14; and fig.1—all); wherein receiving capital contribution information includes receiving an investor identifier associated with the investor, and based at least in part on a correspondence between the investor and the capital contribution information, retrieving the capital contribution information from a computer storage element (col.10, line 10 to col.11, line 35 and fig.1—all); wherein allocating stock rights to the investor includes receiving a fund identifier associated with the fund and based at least in part on a correspondence between the fund identifier and the total capital contribution amount, retrieving the total capital contribution amount from a computer storage element (col.10, line 10 to col.11, line 35; col.25, line 1 to col.71, line 14; and fig.1—all); rights may be options or warrants (col.10, line 10 to col.11, and fig.1—all—not limited to a specific type of security); wherein allocating stock rights to the investor includes calculating a stock ownership percentage in the business entity, wherein said stock ownership percentage is based at least in part on the relation between the capital contribution information and a total capital contribution amount (col.10, line 10 to col.11, line 35; col.25, line 1 to col.71, line 14; and fig.1—all); and a data storage medium, said data storage medium having machine-readable code stored thereon, the machine-readable code including instructions executable by an array of logic elements, the instructions defining a method comprising receiving capital contribution information relating to an amount of capital

contributed by an investor to a venture capital fund, the fund having investments in a portfolio entities and comparing the capital contribution information to a threshold value (col.10, line 10 to col.11, line 35; col.25, line 1 to col.71, line 14; and fig.1—all).

### ***Response to Arguments***

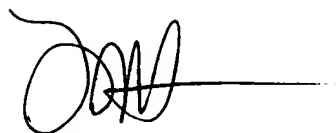
Applicant's arguments with respect to claims 1-19 and 21-25 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M. Hamilton whose telephone number is (571) 272-6743. The examiner can normally be reached on Tuesday-Thursday (6:30-2:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LMH